

REMARKS

Applicants respond to the December 9, 2003 Office Action. The Office Action has asked for cancellation of non-elected claims and has rejected the two pending claims under 35 U.S.C. § 102. In light of the amendments above and the arguments below Applicants respectfully request reconsideration.

On April 8, 2004, Applicant's attorney, Jean C. Baker, spoke with Examiner Wilson about the response to the above-identified Office Action. Examiner Wilson suggested a brief telephonic interview and asked Applicant's attorney to send a copy of a proposed response. Applicant did so.

Applicant's attorney and Examiner Wilson discussed the draft Amendment on Tuesday, April 20, 2004. Examiner Wilson reviewed the claim language with Applicant and transmitted via fax a draft claim for Applicant's consideration. Applicant has now added the Examiner's claim as Claim 30.

Applicants and their attorneys wish to thank Examiner Wilson for the courtesy of his time and for his helpful suggestions. Examiner Wilson had suggested that Applicant examine the § 102 reference and present

language that would distinguish the method of the present invention from the reference. Applicant has done so.

Applicants and their attorneys wish to assert their desire to have the above-added claim allowed at this point in the prosecution procedure without the additional expense of an RCE. Examiner Wilson had mentioned to Applicant's attorney his possible desire to do a new search. Applicants note that the added claim language adds no new subject matter to the claim. The word "vasculogenesis" has been replaced by "development of allantoic mesoderm into blood vessels." This is the accepted definition of "vasculogenesis."

Applicant notes that the claim already contained a limitation to a second allantoic tissue not treated with the compound.

Election/Restriction

As the Office Action requested, Applicants have now formally cancelled claims 1 - 13, 15, 16, 18, 28 and 29. The only claims pending are claim 27 and new claim 30.

Claim Rejection Under 35 U.S.C. § 102

The Office Action has rejected claims 27 and 28 under 35 U.S.C. § 102(b) as being anticipated by Downs (February, 1995 Development, Vol. 121, pages 407-416) for

reasons of record. The Office Action has asserted that the Downs 1995 reference inherently demonstrates the isolation of allantoic tissue, culturing the tissue *in vitro*, treating the allantoic tissue with a test compound and observing vasculogenesis. Applicants have argued that neither Applicant nor anyone else could have understood that vasculogenesis was being observed and that Applicant had inadvertently used the word "vasculogenesis" when "vascularization" was more correctly meant in the reference. Applicants have also argued that the Downs, 1995 reference does not demonstrate the application of a "test compound" to allantoic tissue. Examiner Wilson has not accepted these arguments.

While still continuing to assert that the claims of the present invention are not inherently taught by the Examiner's reference, Applicants wish to emphasize claim language that Applicant believes distinguishes the reference even if the method, as Examiner Wilson postulates, was inherently disclosed in Downs, 1995.

Applicant points to step (d) of new claim 30 where Applicant had noted that one would observe blood vessel formation originating in the allantoic tissue, wherein an "alteration in the development of allantoic mesoderm into

blood vessels in the first allantoic tissue as compared to the second allantoic tissue indicates that the compound alters the development of allantoic mesoderm into blood vessels." Applicant notes that this comparison of allantoic tissue treated with a test compound and not treated with a test compound cannot be found in the Downs, 1995 disclosure. To further emphasize this limitation, Applicant has added language to (a) and (b) to further clarify that an identical allantoic tissue that is not treated with the test compound is provided and observed.

Applicant notes to Examiner Wilson that this language was already in the claim and Applicant is simply making a clarification.

Additionally, Applicant has clarified the definition of vasculogenesis as characterized by mesoderm cells which differentiate into blood vessels (specification page 16, lines 1 - 10). In a previous conversation, Examiner Wilson had suggested that Applicants insert language into the claim that clarify the difference between "vasculogenesis" and "vascularization."

Applicants believe that Downs, 1995 has been removed as a § 102(b) reference.

Examiner Wilson's draft response to Applicant's proposed claim indicated that the Examiner questioned whether the claim language was fully disclosed in the earliest provisional application claiming priority for the above-identified case. Examiner Wilson notes that "Downs, 1998 will have to be considered . . ." Applicant does not agree that the earliest provisional application does not disclose current claim language, but, in the risk of speedy prosecution and Applicant's stated goal of bringing the currently pending claims to allowance in this Office Action, Applicants have enclosed an *In Re* Katz Declaration showing that the authors of Downs, 1998 are the same inventors of the above-identified application. Applicants note that Downs, 1998 is published within a year of the above-identified filing date, June 18, 1999.

Appl. No. 09/336,103
Amdt. Dated April 23, 2004
Reply to Office Action of December 9, 2003

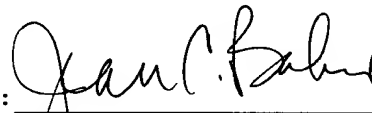
Applicant believes that the claims are in condition for allowance and respectfully request allowance. A Petition and Fee for Extension of Time and a Notice of Appeal are enclosed. If any further fees are necessary, please charge Deposit Account 17-0055.

Respectfully submitted,

Karen M. Downs

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By:



Jean C. Baker
Reg. No. 35,433
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202-4497
(414) 277-5709